

### REMARKS

Claims 1-24 are pending in the present application. Claims 1, 9 and 17 have been amended herewith. Reconsideration of the claims is respectfully requested.

Applicants would initially like to thank the Examiner for taking the time to conduct a telephonic interview with Applicants' representative on February 1, 2005. While no agreement was reached, Applicants' representative described key elements regarding Claim 1 that were not taught by either cited reference.

#### **I. 35 U.S.C. § 103, Obviousness**

The Examiner rejected Claims 1-24 under 35 U.S.C. § 103 as being unpatentable over Townsend et al. (US Patent No. 5,974,562) (hereinafter "Townsend") in view of Yanagidate et al. (US Patent No. 6,128,664) (hereinafter "Yan"). This rejection is respectfully traversed.

The present invention is directed to a system, method and program product for providing a unique and non-obvious technique for synchronizing device addresses between two networks within a data processing system. A plurality of devices are concurrently coupled together using two distinct networks – a first network and a second network. The devices are accessed using the first and second networks concurrently. A plurality of first unique addresses is assigned to each of the devices for the first network. A plurality of second unique addresses assigned to each of the devices for the second network is determined. *Responsive to a determination that a first address is not identical to a second address for one of the devices*, a new address is assigned to that device for the first network such that the new address is used to access the device by the first network. This new address that is used to access the device by the first network is identical to the second address that is used to access the device by the second network.

In contrast, the cited Townsend reference teaches use of *a single network* to access a plurality of devices. Hence, and contrary to the Examiner's assertion, the cited Townsend reference does not teach the claimed step of determining a plurality of second unique addresses assigned to each of the plurality of devices for said *second network* (such second network being in addition to the claimed first network). In addition, and contrary to the Examiner's assertion, the cited Townsend reference does not teach the

claimed step of reassigning a new unique address to the one of the plurality of devices for *the first network* such that the new unique address is used to access the one of the plurality of devices by the first network and is identical to the one of the plurality of second unique addresses that is used to access the one of the plurality of devices by *the second network*.

Specifically with respect to Claim 1, such claim recites steps of (i) assigning a plurality of first unique addresses to each of said plurality of devices for said first network, and (ii) determining a plurality of second unique addresses assigned to each of the plurality of devices for said second network. In rejecting Claim 1, the Examiner states that the cited Townsend reference teaches (i) assigning a plurality of first unique addresses for a first network at column 2, lines 46-48, 60-62, column 4, lines 5-8, 29-30, 32-35, column 5, lines 4-10, 36-37, 44-46; and (ii) determining a plurality of second unique addresses for a second network at column 2, lines 46-48, 60-62, column 4, lines 5-9, column 5, lines 4-10, 14-16, 36-37, 44-45, 47-51. Applicants urge that to the contrary, the cited Townsend reference does not teach both a first and second network, but rather a single network. Because there is only a teaching of a single network, it necessarily follows that there is no teaching of both a first network and a second network, as expressly recited in Claim 1. Accordingly, and directly contrary to the Examiner's assertion, there is no teaching by Townsend of assigning addresses for a first network *and* determining addresses for a second network. To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (emphasis added by Applicants). *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Thus, it is shown that Claim 1 has been erroneously rejected by the Examiner as all of the claim limitations are not taught or suggested by the cited reference.

Still further with respect to Claim 1, such claim recites "responsive to a determination that one of the plurality of first unique addresses is not identical to one of the plurality of second unique addresses for one of the plurality of devices, reassigning a new unique address to the one of the plurality of devices for the first network such that

the new unique address is used to access the one of the plurality of devices by the first network and is identical to the one of the plurality of second unique addresses that is used to access the one of the plurality of devices by the second network". As can be seen, this aspect to Claim 1 describes an action that is taken in response to a determination. In particular, a new address is reassigned to a device (the action) *responsive to a determination that one of the first addresses for a device is not identical to one of the second addresses for the device (the determination), such that the new address is used to access the device by the first network is identical to a second address that is used to access the device by the second network*. In rejecting this aspect of Claim 1, the Examiner states that this claimed reassigning step is taught by Townsend at column 2, lines 25-30, 51-60, 65-67, column 5, lines 23-32, 56-67, column 6, lines 1-10. Applicants show two-fold error in such assertion.

First, and for similar reasons to those described above, Townsend only teaches a single network, and therefore does not teach that the new unique address is used to access the one of the plurality of devices *by the first network* and is identical to the one of the plurality of second unique addresses that is used to access the one of the plurality of devices *by the second network*.

Secondly, while Townsend does teach changing an address (although it is with respect to a single network), such address changing is not responsive to a determination that addresses being used to access a device are not identical, as expressly recited in Claim 1. Rather, the Townsend address change occurs *when the first workstation is about to fail* (Townsend column 2, lines 51-53). Thus, Claim 1 is further shown to have been erroneously rejected for numerous additional reasons (of missing claimed features).

Even if one were to somehow modify the teachings of Townsend to include two networks such as is described by the cited Yan reference, there would still be no teaching or suggestion of "responsive to a determination that one of the plurality of first unique addresses is not identical to one of the plurality of second unique addresses for one of the plurality of devices, reassigning a new unique address to the one of the plurality of devices for the first network *such that the new unique address is used to access the one of the plurality of devices by the first network and is identical to the one of the plurality of*

*second unique addresses that is used to access the one of the plurality of devices by the second network*". This is so for numerous reasons, as will now be described.

First, Yan teaches an environment with two distinct networks and an address-translating connection device that is used to translate addresses between these two networks (col. 1, lines 11-13). Because of this requirement for address translation, the devices on each network by definition have different addresses. Thus, Yan does not teach or suggest reassigning a new unique address to the one of the plurality of devices for the first network such that the new unique address is used to access the one of the plurality of devices by the first network and is identical to the one of the plurality of second unique addresses that is used to access the one of the plurality of devices by the second network. Rather, it teaches address translation, where one address used to access a device is converted to another address that matches the address of the device. *The device's address itself is not re-assigned, as expressly recited in Claim 1.* By analogy, a telephone call-forwarding technique, where when one telephone number is called, the call is actually made to another telephone number, is very different from the person being called having their phone number re-assigned or changed to another number. Thus, even with this combination, there are still missing claimed features not taught or suggested by the resulting combination.

Second, Townsend requires that the main and backup workstations have different addresses – otherwise the system would not operate properly as there would be no way to address or distinguish one from the other when accessing such devices using a network. Thus, even if one were to somehow modify the Townsend teachings to include two networks as taught by Yan, there would still be no teaching or suggestion of "reassigning a new unique address to the one of the plurality of devices for the first network such that the new unique address is used to access the one of the plurality of devices by the first network and is identical to the one of the plurality of second unique addresses that is used to access the one of the plurality of devices by the second network". When both of Townsend's devices are functioning properly, they are required to have different addresses. When only one is functioning properly, such as would be the case when the main workstation failed and the backup workstation has been assigned the address of the failed workstation as a part of providing backup functionality, there still is no teaching or

suggestion of "the new unique address is used to access the one of the plurality of devices by the first network and is identical to the one of the plurality of second unique addresses that is used to access the one of the plurality of devices by the second network".

Still further, Yen does not teach or suggest coupling a plurality of devices together utilizing a first network *and concurrently coupling* said plurality of devices together utilizing a second network, said first network being separate from said second network; and *accessing said plurality of devices utilizing said first and said second networks concurrently*. Rather, Yen teaches devices either coupled to one network (Network (a)) or the other (Network (b)), with an intervening address translating device.

Thus, it has been shown that there are numerous claimed features not taught or suggested by the cited references, and that it would not be possible to somehow modify the resulting combination in accordance with the claimed invention without effectively destroying the operations and purposes of the teachings contained therein, strongly evidencing no motivation to combine and modify such teachings. When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. "...absence of such suggestion to combine is dispositive in an obviousness determination". *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997). Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicants traverse the rejection of Claims 2-8 for reasons given above with respect to Claim 1 (of which Claims 2-8 depend upon).

Applicants traverse the rejection of Claims 9-24 for similar reasons to those given above with respect to Claim 1.

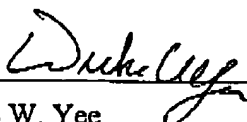
Therefore, the rejection of Claims 1-24 under 35 U.S.C. § 103 has been overcome.

**II. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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